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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,595	07/31/2001	Ashish K. Khandpur	56784US002	2530

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EXAMINER	
CHANG, VICTOR S	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

A5.8

Office Action Summary	Application No.	Applicant(s)
	09/919,595	KHANDPUR ET AL.
	Examiner	Art Unit
	Victor S Chang	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

[illegible] priority under 35 U.S.C. § 119(e) (to a provisional application).

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

[illegible] (PTO-948)

4)☐ [illegible]

5)☐ Notice of Informal Patent Application (PTO-152)

[illegible]

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a foamed pressure sensitive adhesive article, classified in class 428, subclass 343.

II. Claims 17-18, drawn to a multi-layered article, classified in class 428, subclass 304.4.

III. Claims 19-21, drawn to a method of forming a foamed pressure sensitive adhesive article, classified in class 156, subclass 60+.

2. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as insulation tape and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be

3. Inventions Group III and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product, such as a thermal insulation tape.

4. Inventions Group III and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by coextrusion process.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Daniel Pauly on 10/31/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

7. The use of the trademark KRATON has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the phrase "further comprising voids" is vague and indefinite. Please clarify the structural location of the voids, i.e., it is not clear if the voids are in the foamed pressure sensitive polymer.

10. The Examiner would like to suggest change the term "includes" in claims 3 and 4, line 2 in each claim, to --comprises--, so as to be consistent to the remaining claim language.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehlsen et al. (US 6103152).

Gehlsen's invention is directed to polymer foam articles (Abstract). Gehlsen teaches that articles incorporating polymer foam are known. The foam includes a polymer matrix and is characterized by a density that is lower than the density of the polymer matrix itself. Density reduction is achieved in a number of ways, including through creation of gas-filled voids in the matrix (e.g., by means of a blowing agent) or inclusion of polymeric or non-polymeric microspheres (e.g., glass microspheres) (column 1, lines 7-15).

For claims 1-4, Gehlsen teaches that the various polymers are useful as the polymer matrix of the foam, such as polyphenylene oxide alloys (column 7, line 31), block copolymers of styrene and dienes (column 7, line 38), and block copolymer based adhesive (column 7, lines 40-49). In Examples 23 and 50-53, styrene-isoprene-styrene (column 16, lines 57-59) and styrene-ethylene-butylene-styrene block copolymers are used as the polymer matrices (column 19, line 46 to column 20, line 16).

With respect to claims 5-8 and 15, Gehlsen is silent on whether or not the styrenic block copolymer comprises a polymodal asymmetric block copolymer, and also that the polyarylene oxide has a softening temperature of at least 110°C and comprises polyphenylene ether and/or poly(2,6-dimethyl-1,4-phenylene ether). However, it

these equivalents for forming foamed polymer matrices would be within the level of ordinary skill in the art.

With respect to claims 9-10 and 14, Gehlsen teaches that the foam may contain agents in addition to microspheres. Examples of suitable agents include those selected from the group consisting of tackifiers, plasticizers, etc. The foam may also include gas-filled voids in the polymer matrix. Such voids typically are formed by including a blowing agent in the polymer matrix material and then activating the blowing agent, e.g., by exposing the polymer matrix material to heat or radiation (column 2, lines 17-27).

With respect to claims 11-13 and 16, although Gehlsen does not specifically teach the gel content and the peel strength of the adhesive article, the ASTM test results, in the absence of unexpected results, these physical properties are each believed to be either inherently disclosed, or an obvious optimization to one of ordinary skill.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making laminated foamed structure:

US 4610923 to Schrock

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
VSC
October 31, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~ 1700